

### Remarks

The Office Action mailed July 12, 2006 provided a final rejection of pending claims 42-70. The Applicant respectfully requests reconsideration of this final rejection.

### Finality Improper

MPEP 706.07(a) states in part:

*Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). (MPEP 706.07(a), emphasis added)*

The Office Action mailed July 12, 2006 provided new grounds of rejection under 35 U.S.C. §103(a) to dependent claims 47-51, 54, 60-63, 65 and 68. These new rejections were not necessitated by the Applicant's amendments to the claims, nor were these new rejections based on an intervening information disclosure statement (IDS).

The finality of the Office Action mailed July 12, 2006 is therefore improper in view of current Office guidelines. Reconsideration and withdrawal of the finality of the current Office Action are respectfully requested on this basis.

### Rejection of Claims Under 35 U.S.C. §102(e)

Claims 42-46, 52-53, 55-59, 64, 66 were finally rejected as being anticipated by U.S. Published Patent Application No. US 2001/0056362 to Hannagan et al. ("Hannagan '362"). This rejection is respectfully traversed.

The Applicant submits that a *prima facie* case of anticipation has not been established, and the case is not ready for appeal in present form. A *prima facie* case of anticipation requires a showing by the Examiner that each and every limitation of the claim is explicitly or inherently arranged in the cited reference as claimed. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990); MPEP 2131. A limitation is “inherently” present only if the skilled artisan would “necessarily” find it present in the cited reference. *Continental Can v. Monsanto*, 20 USPQ2d 1746 (Fed. Cir. 1991); MPEP 2112.

With respect to claim 42, the Office Action states that the recited “monitoring” step is met by the order processing (OP) module 22 shown in FIGS. 5 and 22 which actively monitors service requests (see Office Action, page 2, lines 21-24 and para. [0279] of Hannagan ‘362). However, in the Response to Arguments Section, the Office Action states that the “monitoring” step is met by the controller 242 shown in FIG. 19 which provides “control” in terms of monitoring the customer bill manager (CBM) 18 process stream (see Office Action, page 17, lines 13-19 and para. [0241] of Hannagan ‘362).

The OP module 22 is separate from the CBM module 18, and there is no indication in Hannagan ‘362 that both are controlled by the controller 242. Indeed, the excerpt from Hannagan ‘362 relied upon by the Examiner indicates that the control operations provided by the controller 242 do not encompass the OP module 22. See Hannagan ‘362, para [0241]; FIGS. 5, 19 and 22.

It is not clear from the record whether the Examiner is considering the monitoring of service requests by the OP 22, or the monitoring of the CBM 18 process stream by controller 242, or both, as constituting the “monitoring” step of claim 42. This lack of clarity as to the basis for the rejection prevents the establishment of a proper *prima facie*

case of anticipation. MPEP 2131.

Next, with regard to the “characterizing” step of claim 42, the Examiner found this to be met by the operation of the event rater and pricer (ERP) module 16. More specifically, the Examiner found the disclosed “usage event” processed by the ERP 16 to correspond to the recited “*usage event related to a usage rate*” of claim 42, and found the disclosed “non-usage event” processed by the ERP 16 to correspond to the recited “*non-usage event not related to a usage rate*” of claim 42. See Office Action, page 3, lines 1-3 and para [0196] of Hannagan ‘362.

However, in the Response to Arguments Section of the Office Action, the Examiner stated, “*Hannagan does not refer to being related to a usage rate, therefore Hannagan teaches the limitation of ‘not being related to a usage rate.’*” (Office Action, page 17, line 21 to page 18, line 2, emphasis added).

The above respective statements in the Office Action at page 3 and at pages 17-18 are directly contradictory. The Examiner cannot reasonably assert that Hannagan both does and does not disclose a usage event related to a usage rate as part of a proper *prima facie* case of anticipation.

The Applicant notes that the ERP 16 is disclosed as rating the received events. Para. [0196], lines 15-17. The Examiner has not indicated that this operation corresponds to the recited “characterizing” step of claim 42, but assuming *arguendo* that it could be so viewed, the Examiner has wholly failed to establish that the system of Hannagan ‘362 proceeds to carry out the “adjusting” and “executing” steps further set forth by claim 42.

With regard to the “adjusting” step of claim 42, the Examiner appeared to identify this as being met by the storing of data in the Billing Event Database by the ERP module

16, as discussed in para [0196] of Hannagan '362. See Office Action, page 3, lines 4-6.

However, in the Response to Arguments Section of the Office Action, the Examiner further referred to para [0198] of Hannagan '362, which states as follows:

*"ERP 16 interacts with both external and internal interfaces. It collects raw usage events from different network elements 28. ERP 16 also supports external interfaces to receive events from external carriers and value-added service providers, and internal interfaces to other subsystems for billing events, such as adjustments."* (Hannagan '362, para. [0198], lines 1-6.

It is thus not clear whether the Examiner is asserting that the "adjusting" step is met by the storing of data to the Billing Event Database, or whether the Examiner is asserting the "adjusting" step is met by one or more of the aforementioned operations. Perhaps the intended answer is "all of the above." If so, this is insufficient to establish anticipation.

With regard to the storing of data, as discussed in the previously filed Response the Applicant maintains that one with skill in the art would not reasonably view the storing of data to a memory as disclosing, explicitly or inherently, the operation of *"adjusting a parameter of the data storage system when the event is characterized as a usage event,"* as recited by claim 42. See Applicant's Response filed April 26, 2006, page 10, lines 14-20. The Examiner has not provided any support for why such storage of data is viewed as constituting the "adjusting" step.

Instead, the Examiner provided the above excerpt from Hannagan '362 which the Applicant respectfully submits is also silent with regard to *"adjusting a parameter of the data storage system when the event is characterized as a usage event,"* as featured by claim 42. Parsing the above language, one with skill in the art would not view interacting with an external or an internal interface to be the same thing as, nor necessarily requiring,

*"adjusting a parameter of the data storage system when the event is characterized as a usage event."*

Collecting raw usage events from different network elements would not be viewed by the skilled artisan as explicitly or inherently disclosing, *"adjusting a parameter of the data storage system when the event is characterized as a usage event."* Supporting external interfaces to receive events from external carriers and value-added service providers would not be viewed by the skilled artisan as explicitly or inherently disclosing, *"adjusting a parameter of the data storage system when the event is characterized as a usage event."*

Supporting internal interfaces to other subsystems for billing events such as adjustments would not be viewed by the skilled artisan as explicitly or inherently disclosing, *"adjusting a parameter of the data storage system when the event is characterized as a usage event."* And finally, the fact that some types of billing events may involve an adjustment to an account would not be viewed by the skilled artisan as explicitly or inherently disclosing, *"adjusting a parameter of the data storage system when the event is characterized as a usage event."*

So at this point, the Examiner has still failed to show how that Hannagan '362 explicitly or inherently discloses a step of *"adjusting a parameter of the data storage system when the event is characterized as a usage event."* None of the above operations explicitly disclose the "adjusting" step of claim 42. Moreover, the Examiner cannot show that one skilled in the art would view the "adjusting" step as being necessarily carried out in conjunction with one or more of the above operations, as required to establish a showing of anticipation by inherency.

The rejection is therefore improper with respect to the "adjusting" step on the basis

that the Examiner has failed to identify what operation(s) are viewed as meeting this language with the particularity required to establish a *prima facie* case of anticipation. The rejection is further improper on the basis that none of the excerpts from Hannagan '362 used by the Examiner actually disclose the "adjusting" step, either explicitly or inherently.

Finally, with regard to the "executing" step of claim 42, the Examiner referred to operation of the OP module 22 as meeting this step on the basis that the OP module purportedly generates "alarms for potential error conditions." See Office Action, page 3, lines 7-10 and Hannagan '362, para [0081]. In the Response to Arguments Section, the Examiner states that generating such alarms is "comparable to the proposed claim limitation in question." Office Action, page 18, lines 11-16.

The Applicant appreciates the clarity provided by the Examiner on this point, but respectfully submits that whether a particular feature may be "comparable" to a claim limitation simply has no relevance in a valid anticipation analysis. As stated above, in order to establish a *prima facie* case of anticipation, each of the limitations of the claim must be explicitly or inherently present in the cited reference as claimed.

Claim 42 does not recite "generating an alarm;" rather, claim 42 features "executing a diagnostic routine when the event is characterized as a non-usage event."

Those having skill in the art in view of the present disclosure would be able to readily discern that "generating an alarm" is not the same thing as "*executing a diagnostic routine,*" and that each could be done with, or without, the other.

The question in a proper anticipation inquiry is whether the "generating an alarm" operation of Hannagan '362 serves to explicitly disclose "*executing a diagnostic routine*" as claimed by claim 42. The answer is clearly no, and this is consonant with the

Examiner's use of the term "comparable" in describing these respective operations.

The next question is whether the skilled artisan would view the "generating an alarm" operation of Hannagan '362 as inherently disclosing "*executing a diagnostic routine*" as set forth by claim 42. The answer is also clearly no, since the skilled artisan would not find such a diagnostic routine to be necessarily executed as a result of the alarm.

Accordingly, a *prima facie* case of anticipation has not been established with regard to the "executing" step of claim 42.

In view of the foregoing, the Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 42, as well as for the claims depending therefrom. As the rejections of independent claims 55 and 69 are similarly deficient for the foregoing reasons, reconsideration and withdrawal of the rejections of these claims, and for the claims depending therefrom, are further respectfully requested.

#### **Rejection of Claims Under 35 U.S.C. §103(a)**

Dependent claims 47-51, 54, 60-63, 65 and 68 were rejected as being obvious over Hannagan '362 in view of various other art of record. These rejections are respectfully traversed on the basis that these claims are patentable as depending from patentable base claims as discussed above.

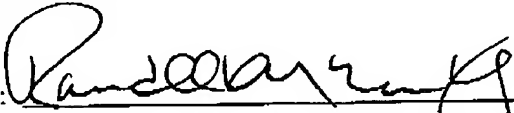
Moreover, in view of the deficiencies of Hannagan '362 discussed above, there is nothing that would motivate one skilled in the art to modify the teachings and suggestions of Hannagan '362, alone or in combination with these other references, to arrive at the claimed subject matter.

Conclusion

This is intended to be a complete response to the Office Action mailed April 12, 2006. Reconsideration and allowance of all of the pending claims are respectfully requested.

Should any questions arise concerning this Response, the Examiner is cordially invited to contact the below-signed attorney.

Respectfully submitted,

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